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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,237	03/10/2000	Michael M. Becker	GP068-03.CN1	5771
21365	7590	02/19/2004		
GEN PROBE INCORPORATED 10210 GENETIC CENTER DRIVE SAN DIEGO, CA 92121				
			EXAMINER LACOURCIERE, KAREN A	
			ART UNIT	PAPER NUMBER
			1635	
DATE MAILED: 02/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/523,237	Applicant(s) BECKER ET AL.	
	Examiner Karen A. Lacourciere	Art Unit 1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 505-554.

Claim(s) objected to: 494-502.

Claim(s) rejected: 492, 503, 504 and 555.


Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Applicant has amended claim 492 to be directed to a kit comprising any nucleic acid polymerase, which broaden the prior claimed subject matter which was directed to claims comprising an RNA polymerase, this amendment requires further search and consideration. Applicant has amended claim 555 to add the limitation wherein the amplification oligonucleotide includes a promoter sequence, this limitation would require a new search and further considerations .

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, Applicant's amendments overcome all rejections of record, however, these amendments have not been entered.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant is arguing the proposed amendments, filed 01-09-2004, however, these amendments have not been entered. Applicant argues that the basis of the rejection of claim 492 was not based on the type of polymerase and, therefore, the proposed amendment would not require a new search and that claim 492 incorporates all of the limitations of objected to claim 495. This is not persuasive because the proposed amendments to claim 492 broaden the scope of the claim and, therefore, would potentially encompass prior art that did not apply to the narrower claim examined in the prior Office action and the proposed amended claim 492 is broader than objected to claim 495, which is limited to kits comprising an RNA polymerase. Applicant argues that the proposed amendment to claim 555 does not require a new search or further considerations because this limitation only makes explicit a limitation required by the functional limitation of the claim. This is not persuasive because the new limitation of a promoter was never recited in the prior claims, nor was it inherent to the functional language.


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PRIMARY EXAMINER